

Serial No. 10/661,759
Page 8

REMARKS

Applicant respectfully requests reconsideration of the present application. Currently 23 claims are pending, wherein claims 1 and 27 are independent. Independent claim 1 is amended to overcome rejections of the claims 2 and 6, which are depending on claim 1. Claims 1-2, 5-8, 11-14, 27-32, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Mayer (USP 6,189,237). Claims 3-4, 9 and 33 are rejected under U.S.C. 103(a) as being unpatentable over Mayer (USP 6,189,237) in view of Anderson (USP 6,207,020). The Applicant respectfully disagrees for the reasons stated below.

1. Claim Rejections Based on 35 USC § 112

The Examiner rejects claims 2 and 6 under 35 USC § 112 as being indefinite for reciting "the moving support" wherein there is no sufficient antecedent basis for this limitation in the claims 2 and 6. Since claims 2 and 6 are dependent on claim 1, the Applicant has amended claim 1 by adding the word "moving" to claim 1 to render the body of this claim consistent with the depended claims 2 and 6. Support for amended claim 1 can be found in the Paragraph 12 of the summary of the present invention.

2. Claim Rejections Based on 35 USC § 102

The Examiner rejects claims 1-2, 5-8, 11-14, 27-32, and 35 under 35 USC § 102(b) as anticipated by Mayer (USP 6,189,237). This rejection is respectfully traversed.

To support a rejection of claims as anticipated under 102 (b), the Examiner must cite a single prior art reference which describes, either expressly or inherently, each and every element of the claim as set forth in the claim (MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir.1987)). The Examiner has not met this requirement.

Serial No. 10/661,759
Page 9

The independent claim 1 recites "means for stripping away at least a portion of the boundary layer from adjacent the second surface of the web..." The independent claim 27 recites "at least one air deflector for stripping away at least a portion of the boundary layer from adjacent the second surface of the web..." There is absolutely no disclosure whatsoever that Mayer (USP 6,189,237) describes or teaches a means such as an air deflector for stripping away a portion of the boundary layer adjacent the second surface of the web as disclosed and recited in claims 1 and 27 of the present invention. In fact, Mayer (USP 6,189,237) teaches away from the present invention in that the guide element 3 is taught to create a boundary layer, rather than strip one away (Col. 5, Lines 33-36). Therefore, Mayer (USP 6,189,237) does not teach and every element of the invention as recited in claims 1 and 27. Claims 2, 5-8, 11-14 (each of which depend from the independent claim 1) are not anticipated by Mayer (USP 6,189,237). Similarly, claims 28-32, 34 and 35 (each of which depend from the independent claim 27) are not anticipated by Mayer (USP 6,189,237). Therefore, Applicant respectfully submits that the rejection should be withdrawn.

3. Claim Rejections Based on 35 USC § 103

Claim 3-4, 9, 33 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Mayer (USP 6,189,237) in view of Anderson (6,207,020). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

Serial No. 10/661,759

Page 10

limitations. Indeed, both the suggestion and the expectation of success must be found in the prior art, not in the Applicant's disclosure. In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1988) (emphasis added). More specifically, the Federal District Court of D.C., which has jurisdiction over the USPTO, recently ruled that the suggestion or motivation to modify or combine prior art must be explicit in the prior art. See Winner Int'l Royalty Corp. v. Wang, 48 USPQ2d 1139 (DCDC 1998). The Applicant believes that the Examiner has failed to make a *prima facie* case of obviousness.

Claims 3, 4, and 9 are dependent on the independent claim 1 and claim 33 is dependent on the independent claim 27. The Examiner has not rejected independent claims 1 and 27 under 35 U.S.C. 103. Applicant respectfully submits that claim 1 is non-obvious over Mayer (USP 6,189,237) in view of Anderson (USP 6,207,020), and As such, claims 3, 4, 9 (all of which depend on claim 1) are non-obvious over Mayer (USP 6,189,237) in view of Anderson (6,207,020), and are therefore allowable in its present form. Similarly, claim 27 is non-obvious over Mayer (USP 6,189,237) in view of Anderson (USP 6,207,020), and As such, claim 33 (which depend on claim 27) is also non-obvious over Mayer (USP 6,189,237) in view of Anderson (USP 6,207,020), and is therefore allowable in its present form.

In addition to above-mentioned deficiencies related to Mayer (USP 6,189,237), the subject matter taught by Mayer (USP 6,189,237) is directed to a process for drying a web. Unlike the present invention as recited in claim 1, Mayer (USP 6,189,237) does not teach means for stripping away at least a portion of the boundary layer from adjacent the second surface of the web. In fact, as noted above, Mayer (USP 6,189,237) teaches to create a boundary layer, rather than strip one away. Moreover, unlike the present invention as recited in claim 27, Mayor (USP

Serial No. 10/661,759

Page 11

6,189,237) also does not teach at least one air deflector for stripping away at least a portion of the boundary layer from adjacent the second surface of the web. The present invention as described in page 13, paragraphs 3 and 4 and recited in claims 9 and 13, teaches 1) that after the web is effectively cooled, it may optionally be re-moisturized by an amount of moisture which may range about 0.5 to 10 grams/m² and 2) that a boundary layer of cool gas adjacent the cooled web is developed after the web is already been cooled.

The Examiner contends that an apparatus for conditioning a web in a paper machine is traveling between a dryer unit and a calendar. The Applicant submits that the present invention is not limited to a particular location wherein the web travels between a dryer unit and a calendar. In fact, as described in page 1, 2nd paragraph and page 2, paragraph 5 of the present invention, "a moving web can be between stages of the process, especially between the later stages of drying and subsequent calendaring" or "an apparatus and method is readily adaptable for use with conventional papermaking machines and processes." Mayer (USP 6,189,237) provides no apparent basis for concluding that a person of ordinary skill in the art would be motivated to modify the apparatus and method described therein so as to arrive at the claimed invention with a reasonable expectation of success in achieving the advantages of the claimed invention as recited in independent claims 1 and 27, and the depended claims 3, 4, 9, and 33; and fully described throughout the specification. Therefore, this rejection is in error and should be withdrawn.

With regards to Anderson (USP 6,207,020) which the moistening means is directed to the surface region of the web as disclosed in Col. 2, Lines 41-46. However, the moistening means of the present invention is not only surface, but also interior surface of the web as described above. Therefore, the cited references neither suggest nor motivate a person of ordinary skill in the art to

Serial No. 10/661,759

Page 12

modify the cited reference so as to arrive at the claimed invention with a reasonable expectation of success in achieving the advantages of the claimed invention. It is readily apparent that the cited references are deficient and thus, the rejection is in error and should be withdrawn.

Serial No. 10/661,759
Page 13

CONCLUSION

Therefore, Applicant respectfully submits that independent claims 1 and 27 define patentable subject matter. The remaining dependent claims 2-14 and 28-35 all of which depend from independent claims 1 and 27 respectively, and therefore also define patentable subject matter. Accordingly, Applicant respectfully request the withdrawal of the rejections under 35 USC § 102 and 35 USC § 103.

In view of the foregoing remarks, the application is believed to be in condition for the allowance, and such action is respectfully requested. Should the Examiner have any remaining questions and the attending to of which would expedite such action, the Examiner is invited to contact the undersigned at the telephone number listed below.

One extension of time is believed to be required. The Commissioner is hereby authorized to charge any such fee to deposit to Deposit Account No. 09-0525.

Respectfully submitted,
DENNIS W ANDERSON

By: Matthew M. Eslami

Matthew M. Eslami, P.E.

Registration No. 45,488

Agent for Applicant

International Paper Company

6285 Tri-Ridge Boulevard

Loveland, Ohio 45140

Phone: (513) 248-6193

Fax: (513) 248-6455

E-mail: matt.eslami@ipaper.com